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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,113	01/25/2005	Christophe Galopin	102790-123 (30053 US2)	1934
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NORRIS, MCLAUGHLIN & MARCUS			EXAMINER	
875 THIRD AVE			DEES, NIKKI H	
18TH FLOOR				
NEW YORK, NY 10022			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			10/15/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/522,113

Applicant(s)

GALOPIN ET AL.

Examiner

Nikki H. Dees

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment filed July 9, 2008, has been entered. Claims 1-12 are currently pending in the application. The previous 101 and 112 rejections of claim 5 have been withdrawn in view of Applicant's amendment to the claim. The previous 102 rejection of claims 1 and 4 over Gamboa-Leon has been withdrawn in view of Applicant's amendments to claim 1. The previous 102 and 103 rejections of claims 1 and 5-9 over Hatasa et al. have been withdrawn in view of Applicant's amendments to claim 1.

Claim Objections


2. Claims 3, 4, and 10-12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
3. Claims 3 and 4 contain structures where "n is 1". However, amended claim 1 limits n as "n is 2." For purposes of examination, claims 3 and 4 will be considered limited to n=2.



4. Claim 10 contains a structure where R'' is

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with $m=2$, R^v selected from methyl and ethyl, and R' selected from H and OH. However,

amended claim 1 requires R^v be ethyl when R'' is  and R' is H. For purposes of examination, claim 10 will be examined with R^v as ethyl when R' is H or R^v is methyl when R' is H.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 4, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gamboa-Leon et al. (Gamboa-Leon, R., Chilton, W.S. 2000.

"Isobutylamide numbing agents of toothache grass, *Ctenium aromaticum*." Biochemical Systematics and Ecology. Vol. 28. pp. 1019-1021).

7. Gamboa-Leon et al. teach the compound N-(1-isobutyl)-2(E),4(E),8-decatrienamide (isoaffinin). This compound is similar to applicant's compound wherein R' is H, R''' and R'''' are methyl, n is 2, R'' is the group



with $m=2$ and R^v is a methyl radical.

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8. Gamboa-Leon state that the chemical shifts for the double bond at C8 overlapped, precluding the assignment of cis-trans.
9. Gamboa-Leon is silent as to the compound wherein R^v is an ethyl radical when R' is H.
10. One of ordinary skill in the art at the time the invention was made, based on the teachings of Gamboa-Leon, would have found a compound differing by an additional –CH₂– in the length of the carbon chain (undecatrieneamide) compared with the prior art (decatrieneamide) obvious over the prior art. "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties." In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). See also In re May, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers prima facie obvious). In the instant case, there would have been a reasonable expectation that the additional –CH₂– of the claimed compound would not significantly alter the properties of the prior art compound.
11. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gamboa-Leon et al. in view of Fox et al. (Fox, M.A., Whitesell, J. 1994. Organic Chemistry. Jones and Bartlett Publishers. p. 79).

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12. Gamboa-Leon et al. teach the isobutylamide N-(1-isobutyl)-2(E),4(E),8-decatrienamide as detailed above.

13. They are silent as to the compound containing an -OH group in the R' position.

14. Fox et al. teach that the substitution of an -OH for a -H of a hydrocarbon alters the boiling point and solubility of the compound.

15. The substitution of an -OH for an -H would be one that is readily apparent to one of ordinary skill in the art. As this change would alter the boiling point and water solubility of the compound, one of ordinary skill would make the substitution depending on the final use of the compound. This change would be within the abilities of one of ordinary skill, and would not require undue experimentation. The resultant compound would be expected to have a slightly altered boiling point and water solubility, and thus be more suitable for particular applications

16. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gamboa-Leon et al. in view of Hatasa et al. (3,720,762).

17. Gamboa-Leon et al. teach N-(1-isobutyl)-2(E),4(E),8-decatrienamide as detailed above. They further state that isobutylamides of unsaturated fatty acids occur widely in certain families of dicotyledonous plants and that isobutylamides are generally known to be pungent, numbing agents.

18. They are silent as to the use of isoaffinin in foods, beverages, or personal care products.

19. The '762 patent teaches spilanthol, another isobutylamide of an unsaturated fatty acid, in foods and oral care products including mouthwashes, gums, and breath fresheners. They further state that the spilanthol has a sharp flavor and a local anesthetic property. The spilanthol may be used alone or in combination with other flavorings (col. 1 lines 47-61). The amount of spilanthol used in the invention ranges from about 0.01 to 5.00 wt % (col. 2 lines 36-37).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used isoaffinin, an isobutyl amide of an unsaturated fatty acid, as taught by Gamboa-Leon et al. in the invention of the '762 patent. One of ordinary skill would have had a reasonable expectation that the isoaffinin would have the same flavor and slight numbing properties as the spilanthol, another isobutylamide of an unsaturated fatty acid. Substitution of one compound for another would not require undue experimentation, and there would have been a reasonable expectation that the resultant foods, beverages and oral care products would maintain their favorable organoleptic properties.

Response to Arguments

21. Applicant's arguments filed July 9, 2008, have been fully considered but they are not persuasive.

22. In response to the 102 rejection of claims 1 and 4 in view of Gamboa-Leon, Applicant argues that the amendment requiring $n=2$ renders the objection moot.

23. The compound of Gamboa-Leon as detailed above contains conjugated double bonds adjacent to the amide group, as is now required by claim 1. The difference between the compound of Applicant's amended claim 1 and the compound of Gamboa-Leon is when R' is H, R^v is ethyl (claimed) or methyl (prior art). This claimed compound, as now required by amended claim 1, is considered obvious over the prior art, as detailed above.

24. Further, "obviousness does not require absolute predictability, only a reasonable expectation of success, i.e., a reasonable expectation of obtaining similar properties." See, e.g., *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

25. Regarding the 103 rejection of claim 2 over Gamboa-Leon in view of Fox, Applicant argues extensively as to the unpredictable nature of compounds as flavors and fragrances.

26. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the unpredictable nature of flavors and fragrances) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

27. The rejected claim 2 is to a compound wherein the indicated R group is OH. One of ordinary skill in organic chemistry at the time the invention was made, wishing to provide a compound wherein an -H was replaced by and -OH. The artisan would have been able to make this substitution based on the knowledge accorded to one of ordinary skill. Undue experimentation would not have been required, and while there would have been an expectation that certain properties of the compound may change, these changes would have been expected and, therefore, obvious. As the compound is not claimed as a flavor or fragrance, those arguments are not addressed further.

28. Regarding the 103 rejection of claims 5-9 over Gamboa-Leon in view of Hatasa, Applicant argues that due to the unpredictable nature of flavors and fragrances, it would not have been obvious to one of ordinary skill to utilize the isoaffinin as taught by Gamboa-Leon in place of the spilanthol as taught by Hatasa (Remarks, p. 14).

29. Both isoaffinin ((2E, 4E, 8Z)-N-isobutyldeca-2,4,8-trienamide) as taught by Gamboa-Leon, and spilanthol ((2E, 6Z, 8E)-N-isobutyldeca-2,6,8-trienamide) are known to be isobutyl amides of unsaturated fatty acids having pungent, numbing properties. As these compounds were both known in the art at the time the invention was made, the unpredictable nature that Applicant refers to is not considered to be applicable, and one of ordinary skill would have been able to use the compound as taught by Gamboa-Leon in the products as taught by Hatasa without undue experimentation, and with a reasonable expectation that the compositions would continue to be suitable for oral use.

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30. Further, Applicant has not shown the criticality of the additional -CH₂- to result in an undecatrieneamide as claimed versus the decatrieneamide of the prior art. Applicant argues the unpredictable nature of stereoisomers with regard to odors. However, the compounds of Applicant's instant invention are not stereoisomers of the prior art compounds and thus the arguments are not considered pertinent to the instant rejection.

Conclusion

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nikki H. Dees
Examiner
Art Unit 1794

/Carol Chaney/
Supervisory Patent Examiner, Art Unit 1794